

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Arthur A. SCHEIN, *et al.*

Serial No.: **09/737,754**

Art Unit: **3629**

Filed: **December 18, 2000**

Examiner: **Naresh VIG**

For: **GLOBAL FINANCIAL SERVICES INTEGRATION SYSTEM AND PROCESS**

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APPEAL BRIEF

This is an Appeal Brief under 37 C.F.R. § 41.37 in connection with the Advisory Action mailed on February 19, 2010. Each of the topics required by Rule 41.37 is presented herewith and is labeled appropriately. This Appeal Brief is being submitted within 2 months from the date of filing of the notice of appeal under § 41.31 on February 22, 2010.

(1) Real Party In Interest

The real party in interest is Citibank, N.A., having an office at 399 Park Avenue, New York, New York 10043.

(2) Related Appeals And Interferences

The Board previously issued a Decision on Appeal on September 25, 2008. *See* Appeal 2007-3392.

(3) Status Of Claims

Claims 21 and 23-52 are pending on this application. Claims 21 and 23-52 stand under final rejection, from which rejection this appeal is taken.

(4) Status of Amendments

The claims have not been amended after the Final Office Action dated November 20, 2009.

(5) Summary of the Claimed Subject Matter

This summary of claimed subject matter is a concise explanation of the subject matter defined in independent claims 21, 42, and 49. This is merely meant to be a summary and is in no way intended to limit the pending claims.

In one embodiment, as recited in claim 21, a global communications network is used by a financial institution. Page 25, lines 14-24. A plurality of distribution points allow an end user to send an electronic message or request. Page 26, lines 19-25. An integration facility controls and routes the electronic message or request. Page 27, lines 22-24. The integration facility has at least one first logical router for determining whether the electronic message or request is simple or complex. Page 29, lines 6-7. The electronic message or request is routed based upon that determination. Page 25, lines 15-30. The complex message or request comprises a transfer message or request or a package message or request. Page 21, line 16 - page 22, line 5; FIGS. 4 and 5. At least one service provider processes the electronic message or request. Page 29, lines 7-14.

In another embodiment, as recited in claim 42, a method processes and routes an electronic message or request across a global communications network. Page 27, lines 22-24. An electronic message or request is received from a distribution point. Page 26, lines 19-25. It is determined whether the electronic message or request is simple or complex. Page 29, lines 6-7. The electronic message or request is routed based upon that determination. Page 25, lines 15-30.

The complex message or request comprises a transfer message or request or a package message or request. Page 21, line 16 - page 22, line 5; FIGS. 4 and 5. A simple message or request is routed to at least one service provider. Page 29, lines 7-9. A complex message or request is processed and then routed to at least one service provider. Page 29, lines 11-14.

In yet another embodiment, as recited in claim 49, a communication network has an integration facility, a distribution point, a financial transaction related service, and a service provider⁰. Page 26, lines 1-3. An integration facility processes electronic messages or requests. Page 27, lines 22-24. The integration facility has at least one first logical router for determining whether the electronic message or request is simple or complex. Page 29, lines 6-7. The electronic message or request is routed based upon that determination. Page 25, lines 15-30. The complex message or request comprises a transfer message or request or a package message or request. Page 21, line 16 - page 22, line 5; FIGS. 4 and 5. At least one distribution point is in communication with the integration facility. Page 28, lines 2-3. At least one financial transaction related service is in communication with the integration facility. Page 27, lines 8-13. At least one service provider is in communication with the integration facility. Page 27, lines 14-17.

(6) Issues

- A. Whether the Examiner's rejection of claims 21, 23-31, 33-38, and 40-48 under U.S.C. § 102(b) as being unpatentable over "Examples of Using MQSeries on S/390, RISC System/6000, AS/400 and PS/2" (hereinafter known as "MQSeries") is proper.
- B. Whether the Examiner's rejection of claim 32 under 35 U.S.C. § 103(a) as being unpatentable over MQSeries in view of Richards et al. (U.S. Patent No. 5,995,921) (hereinafter known as "Richards") is proper.
- C. Whether the Examiner's rejection of claims 39 and 49-52 under 35 U.S.C. § 103(a) as being unpatentable over MQSeries in view of Yanai et al. (U.S. Patent No. 5,544,347) (hereinafter known as "Yanai") is proper.

(7) Argument

A. Whether the Examiner's rejection of claims 21, 23-31, 33-38, and 40-48 under U.S.C. § 102(b) as being unpatentable over MQSeries is proper.

The Examiner's rejection of claims 21, 23-31, 33-38, and 40-48 under 35 U.S.C. § 103(a) as being unpatentable over MQSeries is improper. MQSeries fails to disclose each and every element of independent claims 21 and 42.

1. MQSeries Does Not Route Messages Based on the Type of Message

The previous Decision on Appeal likened MQSeries's "batch" messages to complex messages and "non-batch" or "immediate" messages to simple messages. However, the Decision on Appeal has not opined and the Examiner has not established how MQSeries routes a message based on whether the message is batch or non-batch (immediate). In a Response to Non-Final Office Action after the Decision on Appeal, claims 21 and 49 were amended to recite "at least one first logical router for determining whether the electronic message or request is simple or complex and routing the electronic message or request based upon that determination." The Examiner has maintained a rejection of these claims despite the claim amendment.

Although MQSeries handles batch and non-batch messages with a different priority, MQSeries routes those messages to the same place. Indeed, MQSeries must address the priority of handling of the immediate inquiries before the batch inquiries because the messages are routed to the same location. "The user interface process selects between immediate and batch processing by specifying a different reply-to queue in the inquiry message. It also sends the inquiry messages with different priorities to make sure immediate inquiries are processed ahead of batch inquiries." MQSeries, page 33. None of the modules disclosed in MQSeries, including MVB1, MVB2, and MVB4, route messages based on a determination of whether the message is simple or complex.

Furthermore, MQSeries confirms that it does not route the batch and non-batch messages differently. MQSeries clearly states, "The background processes (MVB2-5) are not aware of the difference between immediate and batch processing." MQSeries, page 33. On page 4, the Decision on Appeal repeats the Examiner's assertion that "MVB2 teaches capability for determining simple and complex messages." As noted in the Decision on Appeal, the Examiner "references router MVB2 (FF1) determinations of BATCH or non-BATCH conditions, and not

the functions of MVB4/5.” Page 10, note 1. Because MVB2 is not aware of the difference between immediate and batch processing, it cannot be a “logical router for determining whether the electronic message or request is simple or complex and routing the electronic message or request based on that determination,” as recited in claim 21 and similarly recited in claim 42.

The Decision on Appeal suggests that “at MVB1 a determination is made as to whether the application is BATCH or non-BATCH (FF 3, 4). Thereafter, based on this determination, at other nodes, for example at MVB2, processing of the message will be handled differently if it is a BATCH message from one that is not.” Page 10. But MVB1 does not route the messages differently based on whether the messages are batch or non-batch. Instead, all of the messages from MVB1 are sent to MVB2. MQSeries, page 34. As discussed above, MVB2 is not aware of the difference between batch and non-batch, so MVB2 cannot route the messages accordingly.

More recently, the Examiner asserts that MVB4 provides the claimed functionality. In the Final Office Action mailed November 20, 2009, the Examiner asserts that MQSeries discloses this aspect on pages 31 and 34 by reciting that “MVB4 receives message, determines whether to route it to MVB5 for further processing, or route the message directly.” *See* Final Office Action, page 3. However, like the other modules in MQSeries, MVB4 does not route a message based on whether it is simple or complex, or whether the messages are batch or non-batch/immediate. Pages 31 and 34, as cited by the Examiner, do not support the assertion that MVB4 makes such a determination and routes accordingly. Indeed, MQSeries recites that MVB4 merely “demonstrates the distribution of a query message to a number of queues, whose names are obtained from a namelist.” Page 36. Further, MQSeries recites that “[t]he background processes (MVB2-5) are not aware of the difference between immediate and batch processing.” Page 33. In other words, MQSeries explicitly states that MVB2, MVB3, **MVB4**, and MVB5 are not aware of the difference between immediate (simple) and batch (complex) messages. So MVB4 **cannot** determine whether to route a message to MVB5 based on a determination of whether the message is simple or complex.

In the Advisory Action mailed February 19, 2010, the Examiner merely asserts that “the office action mailed 20 November 2009 demonstrates how the cited reference(s) teaches the claimed invention.” *See* Advisory Action, page 2. This response fails to clarify any of the Examiner’s inconsistencies or address these remarks.

Thus, neither MVB2, as previously asserted by the Examiner, or MVB4, now asserted by the Examiner, determines whether the message is simple or complex and then routes the message based on whether it is simple or complex. Therefore, MQSeries fails to disclose each and every element of independent claims 21 and 42.

2. MQSeries Does Not Disclose Transfer or Package Messages

On page 3 of the Final Office Action, the Examiner recognizes that “MQSeries does not explicitly recite the complex electronic message or request to comprise a transfer message or a package message.” Claims 21 and 42 recite “wherein the complex electronic message or request comprises: a transfer message or request, or a package message or request.” Thus, the Examiner has submitted that he has not established a *prima facie* case of anticipation based on MQSeries.

In order to cure this deficiency, the Examiner then asserts that “as currently claimed, complex electronic message or request comprising a transfer message or a package message is Non Functional.” This assertion is improper in at least two respects. First, whether the element is “non-functional” can be a useful determination for subject matter eligibility under 35 U.S.C. § 101. But such a conclusion is not germane to a rejection under 35 U.S.C. § 102(b). Second, functional language may be relevant to scope of an apparatus claim, but that language is acceptable in a method claim. *See* MPEP 2114, 2173.05(g). The Board and the Examiner have both considered the functionality of “complex” and “simple” messages, and this contended aspect is directed the types of complex messages. Thus, the Examiner’s assertion regarding the functionality of these claims does not effectively rebut their patentability.

The Examiner further continues to explain that “it would have been obvious to one of ordinary skill in the art to modify MQSeries and allow message content to be a complex electronic message or request to comprising a transfer message or a pack message to be able to customize the solution for specific solution, apply a known technique to a known device (method, or product) ready for improvement to yield predictable results, known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art.” Final Office Action, page 3. However, this entirely conclusory statement is not supported by MQSeries or any other evidence, and it is not supported by any specific reasoning other than relying on generic reasons for obviousness. Furthermore, the

Examiner has rejected these claims as being anticipated by MQSeries, but now asserts that certain features of the claimed invention would be obvious in order to cure the deficiencies of the *prima facie* case. As the Examiner has recognized that MQSeries does not disclose this aspect, the Examiner necessarily will be unable to find any support in MQSeries for its teaching.

Accordingly, because MQSeries does not disclose all of the elements of independent claims 21 and 42, the Office has failed to establish the required *prima facie* case of unpatentability. Similarly, the Office has failed to establish a *prima facie* case of unpatentability for claims 23-31, 33-38, 40-41, and 43-48 depending on claims 21 and 42 and which recite further specific elements that have no reasonable correspondence to the references. Accordingly, the undersigned representative respectfully requests that the rejection of claims 21, 23-31, 33-38, and 40-48 be reversed.

B. Whether the Examiner's rejection of claim 32 under 35 U.S.C. § 103(a) as being unpatentable over MQSeries in view of Richards is proper.

The Examiner's rejection of claim 32 under 35 U.S.C. § 103(a) as being unpatentable over MQSeries in view of Richards is improper. Claim 32 is dependent upon claim 21, which is submitted to be allowable in view of MQSeries for the reasons set forth above. Accordingly, claim 32 should be allowable under MQSeries for these reasons as well. Further arguments are reserved with respect to dependent claim 32. Richards does not cure the deficiencies of MQSeries. Because Richards does not teach or suggest the deficiencies of MQSeries, claim 32 is not obvious in view of the cited references and should therefore be allowed. Therefore, the undersigned representative respectfully requests that the Office withdraw the rejection of claim 32.

C. Whether the Examiner's rejection of claims 39 and 49-52 under 35 U.S.C. § 103(a) as being unpatentable over MQSeries in view of Yanai is proper.

The Examiner's rejection of claims 39 and 49-52 under 35 U.S.C. § 103(a) as being unpatentable over MQSeries in view of Yanai is improper.

Claim 39 is dependent upon claim 21, which is submitted to be allowable in view of MQSeries for the reasons set forth above. Yanai fails to cure the deficiencies of MQSeries. Therefore, MQSeries and Yanai, alone or in combination, do not teach or suggest the elements of

claim 21 of the present application. Because Yanai does not teach or suggest the deficiencies of MQSeries, claim 39 is not obvious in view of the cited references and should therefore be allowed.

With regard to claim 49, MQSeries fails to teach “at least one first logical router for determining whether the electronic message or request is simple or complex and routing the electronic message or request based upon that determination,” as discussed above with respect to claims 21 and 42. Yanai fails to cure the deficiencies of MQSeries. The Examiner relies on Yanai only for “data mirroring.” Indeed, Yanai is directed to maintaining a copy of a data storage disk and fails to teach routing different types of messages. Therefore, MQSeries and Yanai, alone or in combination, do not teach or suggest the elements of claim 49 of the present application.

Accordingly, because the cited reference does not disclose all of the elements of independent claim 49, the Examiner has failed to establish the required *prima facie* case of unpatentability. Similarly, the Examiner has failed to establish a *prima facie* case of unpatentability for claims 50-52 depending on claim 49 and which recite further specific elements that have no reasonable correspondence to the references. Accordingly, the undersigned representative respectfully requests that the Office withdraw the rejection of claims 49-52.

(8) Claims Appendix

1-20. (Cancelled)

21. (Previously Presented) A global communications network for use by a financial institution, comprising:

a plurality of distribution points for allowing an end user to send an electronic message or request;

an integration facility for controlling and routing the electronic message or request, wherein the integration facility comprises at least one first logical router for determining whether the electronic message or request is simple or complex and routing the electronic message or request based upon that determination;

wherein the complex electronic message or request comprises:

a transfer message or request, or

a package message or request; and

at least one service provider for processing the electronic message or request.

22. (Cancelled)

23. (Previously Presented) The network of claim 21, wherein the at least one first logical router directs the simple electronic message or request directly to the at least one service provider.

24. (Previously Presented) The network of claim 21, wherein the at least one first logical router directs the complex electronic message or request to at least one messaging services agent.

25. (Previously Presented) The network of claim 24, wherein the at least one messaging services agent processes the complex electronic message or request based on at least one of processing scripts, workflow rules, data model rules, and business rules, and wherein the at least one messaging services agent directs the processed complex electronic message or request to at least one second logical router.

26. (Previously Presented) The network of claim 25, wherein the at least one second logical router directs each processed electronic message or request based on routing criteria developed from at least one of data partitioning, load balancing and site availability to at least one service provider.

27. (Previously Presented) The network of claim 25, wherein the at least one second logical router directs the processed complex electronic message or request to at least one service provider.

28. (Previously Presented) The network of claim 27, wherein the at least one second logical router directs the processed complex electronic message or request based on routing criteria developed from at least one of data partitioning, load balancing and site availability.

29. (Previously Presented) The network of claim 24, wherein the at least one messaging services agent decomposes the complex electronic message or request based on at least one of processing scripts, workflow rules, data model rules, and business rules, into a plurality of simple electronic messages or requests and wherein the at least one messaging services agent directs the plurality of simple electronic messages or requests to at least one second logical router.

30. (Previously Presented) The network of claim 21, further comprising a system journal for maintaining a log of the electronic message or request.

31. (Previously Presented) The network of claim 21, further comprising at least two data centers, wherein each data center of the at least two data centers comprises at least one data storage device for storing data necessary to process the electronic message or request.

32. (Previously Presented) The network of claim 21, wherein the distribution points comprise:

audio and visual devices for interaction with the end user;

translation software for translating all functions communicated to the end user audibly and visually into the end user's preferred language; and

a common interface by which the end user can send the electronic message or request.

33. (Previously Presented) The network of claim 21, wherein at least one distribution point of the plurality of distribution points is chosen from a group consisting of branch systems, remote delivery systems, customer service systems, point of sale systems, and office systems.

34. (Previously Presented) The network of claim 21, wherein a first distribution point of the plurality of distribution points, comprises:

a branch router in communication with the integration facility and a public network;

at least one general service; and

a local area network in communication with the at least one general service and the public network.

35. (Previously Presented) The network of claim 34, wherein the at least one general service comprises at least one printer, automated teller, customer activated services terminal, staff workstation and terminal server, express deposit device, teller work stations, greeter workstations or investment consultant work stations.

36. (Previously Presented) The network of claim 34, wherein a second distribution point of the plurality of distribution points, comprises:

a remote delivery router in communication with the integration facility and the public network; and

at least one remote device, wherein the at least one remote device is in communication with the public network.

37. (Previously Presented) The network of claim 36, wherein a third distribution point of the plurality of distribution points, comprises:

a point-of-service server in communication with the integration facility and a point-of-service network; and

a terminal device, wherein the terminal device is in communication with the point-of-service network.

38. (Previously Presented) The network of claim 37, wherein the point-of-service network is the public network.

39. (Previously Presented) The network of claim 21, wherein a first distribution point of the plurality of distribution points, comprises:

a remote delivery router in communication with the integration facility and a public network; and

at least one remote device, wherein the at least one remote device is in communication with the public network, and wherein the at least one remote device is selected from a group consisting of a computer modem, a voice telephone, a digital phone, a video phone, a personal digital assistant and a smart card.

40. (Previously Presented) The network of claim 21, wherein a first distribution point of the plurality of distribution points, comprises:

a point-of-service server in communication with the integration facility and a point-of-service network; and

a terminal device, wherein the terminal device is in communication with the point-of-service network, and wherein the terminal device comprises at least one of a magnetic strip reader or a key pad.

41. (Previously Presented) The network of claim 40, wherein the point-of service network is at least one of a public network or a private network.

42. (Previously Presented) A method for processing and routing an electronic message or request across a global communications network, the method comprising the steps of:

receiving an electronic message or request from a distribution point;

determining whether the electronic message or request is simple or complex;

based upon the determination, routing a simple electronic message or request to at least one service provider, or processing a complex message or request and routing the processed complex message or request to at least one service provider,

wherein the complex electronic message or request comprises:

a transfer message or request, or

a package message or request.

43. (Previously Presented) The method of claim 42, wherein the at least one service provider communicates with a data center, and wherein the data center comprises at least one data storage device for storing data necessary to complete the simple electronic message or request and the complex message or request.

44. (Previously Presented) The method of claim 42, wherein the steps of processing the complex message or request and routing the processed complex message or request, comprises the steps of:

decomposing the complex message or request based on at least one of processing scripts, workflow rules, data model rules and business rules into a plurality of simple messages or requests; and

routing the plurality of simple messages or requests to the at least one service provider where the plurality of simple messages are processed.

45. (Previously Presented) The method of claim 44, wherein the steps of processing the complex message or request and routing the processed complex message or request, further comprises:

recomposing responses from the at least one service provider; and
routing the recomposed responses to the distribution point.

46. (Previously Presented) The method of claim 44, wherein the step of routing the plurality of simple messages or requests, comprises the step of routing the each simple message or request of the plurality of simple messages or requests based on routing criteria developed from at least one of data partitioning, load balancing and site availability.

47. (Previously Presented) The method of claim 42, wherein the step of routing the processed complex message or request to at least one service provider, comprises the step of routing the complex message or request based on routing criteria developed from at least one of data partitioning, load balancing and site availability.

48. (Previously Presented) The method of claim 42, further comprising the step of maintaining a log of the electronic messages or requests.

49. (Previously Presented) A communications network, comprising:
an integration facility for processing electronic messages or requests, wherein the integration facility comprises at least one first logical router for determining whether the electronic message or request is simple or complex and routing the electronic message or request based upon that determination;

wherein the complex electronic message or request comprises:

- a transfer message or request, or
- a package message or request;

at least one distribution point in communication with the integration facility;

at least one financial transaction related service in communication with the integration facility;

at least one service provider in communication with the integration facility.

50. (Previously Presented) The network of claim 49, wherein the at least one distribution point is selected from a group consisting of branch systems, remote delivery systems, customer service systems, point of sale systems and office systems.

51. (Previously Presented) The network of claim 49, wherein the at least one financial transaction related service is selected from a group consisting of end-to-end management services, financial control services, structured services and unstructured services.

52. (Previously Presented) The network of claim 49, wherein the at least one service provider is selected from a group consisting of gateways, product processors and authorization engines.

(9) Evidence Appendix

None.

(10) Related Proceedings Appendix

A copy of the Decision on Appeal on September 25, 2008 is attached hereto.

CONCLUSION

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account 50-4402.

Respectfully submitted,

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR A. SCHEIN, PAUL ARON, DAN A. DEMETER,
FARAZ ATAIE, FRANK BAMBERGER, JOHN MCGLYNN,
FLORENCE MUSALO, MARGOT PAUL, JOHN POPLIZIO, LUCILA
UCHIE RICO, MICHAEL TSIEN, and MICHAEL YORKE

Appeal 2007-3392
Application 09/737,754
Technology Center 3600

Decided: September 25, 2008

Before HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A.
FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 21 and 23-52. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a method and related apparatus for a global standard messaging service which is an aid to permit rapid communication among worldwide users of the service. (Specification 1:21-23.)

Claim 21, reproduced below, is representative of the subject matter on appeal.

21. A global communications network for use by a financial institution, comprising:
a plurality of distribution points for allowing an end user to send an electronic message or request;
an integration facility for controlling and routing the electronic message or request, wherein the integration facility comprises at least one first logical router for determining whether the electronic message or request is simple or complex; and
at least one service provider for processing the electronic message or request.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Yanai	US 5,544,347	Aug. 6, 1996
Richards	US 5,995,921	Nov. 30, 1999

Examples of Using MQSeries on S/390, RISC System/6000, AS/400 and PS/2 3-75 (1st Ed., IBM Corp., Jun. 1994)(hereinafter referred to as MQSeries.)

The following rejections are before us for review.

1. Claims 21, 23-31, 33-38, and 40-48 stand rejected under U.S.C. § 102(b) as being unpatentable over MQSeries.
2. Claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over MQSeries in view of Richards.
3. Claims 39 and 49-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over MQSeries in view of Yanai.

ISSUE

The anticipation issue before us is whether Appellants have shown that the Examiner erred in rejecting claims 21, 23-31, 33-38, and 40-48 under 35 U.S.C. § 102(b) as anticipated by MQSeries. This anticipation issue turns on whether MQSeries expressly or inherently discloses a logical router for determining whether the electronic message or request is simple or complex.

The second issue is whether Appellants have sustained their burden of showing that the Examiner erred in rejecting claim 32 under 35 U.S.C. § 103(a) as being unpatentable over MQSeries in view of Richards.

The third issue is whether Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 39 and 49-52 on appeal as being unpatentable under 35 U.S.C. § 103(a) over MQSeries in view of Yanai.

FINDINGS OF FACT

1. The Examiner found:

MVB2 teaches capability for determining simple and complex messages. MVB2 responds to the inquiry from MVB1 either from batch processing, immediate delivery, send a query to MVB3 or to MVB4 for further processing. Looking at this figure itself, it would have been obvious to one of ordinary skill in the art that MVB2 is capable of determining whether the message is simple or complex as claimed by the appellant as their invention.

(Answer 14-15.)

2. MQSeries discloses that

[t]he Credit Check sample application is a suite of CICS programs written in COBOL. The application demonstrates a method of assessing the risk when bank customers ask for loans. The application shows how a bank could work in two ways to process loan requests:

- When dealing directly with a customer, the bank staff can have immediate access to account and credit-risk information
- When dealing with written applications, the bank staff can submit a series of requests (batch) for account and credit-risk information, and deal with the replies at later time.

(MQSeries 33.)

3. MQSeries discloses that

[t]he user interface process selects between immediate and batch processing by specifying a different reply-to queue in the inquiry message. It also sends the inquiry messages with different priorities to make sure immediate inquiries are processed ahead of batch inquiries.

(MQSeries 33.)

4. MQSeries discloses that the MVB1 is a module having the following attributes:

Module Name CSQ4CVB1
Environment CICS/ESA Version 3.3; COBOL II
CICS Transaction MVB1
Description This program provides the user interface function for the Credit Check sample. It demonstrates the basic entry into an application and how to kick off the messaging process.
Function Handles the screen interface to obtain the account information from the user. Generates the initial message that triggers the actual Credit Check application procedures. Retrieves the reply from the application and displays results on the screen.

(MQSeries 35.)

5. MQSeries discloses that MVB2 router

[p]rovides the application manager function for the Credit Check sample.
Demonstrates the decomposition of a business application into single units of work to be executed in parallel.
Function Reads the message created by

CSQ4CVB1 and decomposes the request implied by this message into two other request messages. Puts the two new messages into their respective queues.

Waits for the replies (several) from the processes that handle the decomposed messages and re-composes them into the reply to CSQ4CVBI.

(MQSeries 35.)

6. MQSeries discloses that the MVB4 server

[p]rovides the distribution process function for the Credit Check sample.

Demonstrates the distribution of a query message to a number of queues, whose names are obtained from a namelist. In addition, demonstrates the notification of the originator, through its reply queue, of the number of messages that have been distributed - and therefore, of the number of replies the originator (MVB2) should expect.

Reads the message created by CSQ4CVB2 and retrieves a list of queues from the namelist.

Writes triggering messages to each queue named in the namelist to kick off the MVB5 transaction.

Writes a reply message to reply-to queue.

[Is restricted by a] maximum of 10 queues can be specified in the namelist. The program is only triggered if the loan amount requested is greater than 10,000 dollars.

(MQSeries 36.)

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (citing *Graham*, 383 U.S. at 12), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be

obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740.

ANALYSIS

Initially, we note that the Appellants argue claims 21 and 42 together as a group. Correspondingly, we select representative claim 21 to decide the appeal of these claims. Remaining claims 23-31, 33-38, and 40, 41, 43-48 stand or fall with claim 21 since Appellants have not challenged such with any reasonable specificity (*see In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

We begin our analysis by interpreting the language of the claims. At issue in this appeal is the meaning of the terms “simple or complex.” We refer to the Specification for guidance and find that a complex message is one which requires supervision and a simple one does not (Specification 40:8-9). Appellants give as an example of supervision sending a message to a messaging service agent 8 which “processes the message using, among

other criteria, the script/workflow data model rules 31, then directs the complex message along line 33 to second logical router 35.” (Specification 40:17-20.) Thus, we interpret “supervise” to be an additional set of commands which control the downstream processing of a message.

The Examiner argues that MVB2 teaches the capability for determining simple and complex messages because MVB2 responds to the inquiry from MVB1 either from batch processing or immediate delivery, and then sends a query to MVB3 or to MVB4 for further processing (FF 1).¹

Appellants argue that “[n]one of the MVB1 functions above disclose ‘determining whether the electronic message or request is simple or complex.’” (Appeal Br. 9.) We do not agree with Appellants because at MVB1 a determination is made as to whether the application is BATCH or non-BATCH (FF 3, 4). Thereafter, based on this determination, at other nodes, for example at MVB2, processing of the message will be handled differently if it is a BATCH message from one that is not. If it is a BATCH message, the resulting message requires supervision in the form of BATCH commands which govern the priority of routing the messages (FF 3). That is, MQSeries discloses that a determination is made between immediate or batch processing which means a series of requests (batch) are sent for

¹ The Examiner’s Answer maintains the same grounds of rejection as to all the rejections made under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) covering claims 21 and 23-52, but uses other reasoning as to how MQSeries is interpreted. The Examiner’s Answer references router MBV2 (FF1) determinations of BATCH or non-BATCH conditions, and not the functions of MVB4/5. Appellants did not file a Reply Brief in response to this reasoning, so we use only those points advanced by Appellants’ that are relevant to the Examiner’s reasoning using MBV2.

account and credit information and dealt with later in time (FF 2). Thus, as between BATCH versus immediate processing (non-BATCH), different reply to queue messaging occurs (FF 3). The messages shepherded through the system as BATCH are thus under the supervision of BATCH commands and are read as complex messages, leaving a non-BATCH message to be a read as simple messages.

Appellants also argue that

MQSeries does not disclose how the PS/2, MVS/ESA, AS/400, or the RS/6000 could perform the function of "determining whether the electronic message or request is simple or complex." Figure 11 does not distinguish between the types of messages being transmitted nor is that functionality disclosed elsewhere in the reference. Therefore, MQSeries does not disclose each and every element of claim 21 of the present application.

(Appeal Br. 7.)

We are not persuaded by Appellants' argument that MQSeries does not disclose a logical router which could perform the function of "determining whether the electronic message or request is simple or complex" because as found *supra* (FF 2, 3), MBV1 selects between immediate and batch processing by specifying a different reply-to queue in the inquiry message, and thus causes a system-wide distinction to be made (FF 5, 6) in messages as either BATCH or non-BATCH. As discussed *supra*, we interpret this distinction to be determined by the need to supervision the message, which controls whether the message is simple or complex.

As such, we sustain the rejection of claims 21, 23-31, 33-38, and 40-48 under U.S.C. § 102(b) as being unpatentable over MQSeries.

Appellants' argument as to claim 32 being improperly rejected under 35 U.S.C. § 103(a) merely restates the arguments for the dependent claim 21 on which it is based. As such, we sustain the rejection of claims 32 as well.

Likewise, Appellants' argument as to the allowability of independent claim 49 merely restates the arguments previously addressed in conjunction with independent claims 21 and 42. As such, we sustain the rejection of claims 49. We also affirm the rejections of dependent claims 39, and 50-52 since Appellants have not challenged such with any reasonable specificity.

CONCLUSIONS OF LAW

We conclude:

We affirm the rejection of claim 21, 23-31, 33-38, and 40-48 under U.S.C. § 102(b) as being unpatentable over MQSeries.

We affirm the rejection of claim 32 stands under 35 U.S.C. § 103(a) as being unpatentable over MQSeries in view of Richards.

We affirm the rejection of claims 39 and 49-52 under 35 U.S.C. § 103(a) as being unpatentable over MQSeries in view of Yanai.

DECISION

The decision of the Examiner to reject claims 21 and 23-52 is
AFFIRMED.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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